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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,062	02/17/2004	Calvin Lam	C&M1.PAU.19	9669
23386 7590 04/30/2008 MYERS DAWES ANDRAS & SHERMAN, LLP 19900 MACARTHUR BLVD. SUITE 1150 IRVINE, CA 92612				
EXAMINER				
FONSECA, JESSIE T				
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3633				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/780,062

**Applicant(s)**

LAM, CALVIN

**Examiner**

JESSIE FONSECA

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 10, 12, 13, 15-17 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 12, 13, 15-17 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

The supplement application data sheet submitted 11/16/07 has been accepted.

### ***Drawings***

The drawings were received on 11/16/07. These drawings are not acceptable as outstanding issues exist.

The drawings are objected for the following:

- Figure 5: The inclusion of vertical solid lines on the front and rear outer faces implies the zig-zag joints are angled along those faces. It is noted that in fig. 6, the front and rear faces are planar in which no vertical solid lines are present. Furthermore, the hidden lines representing zig-zag shapes are not properly drawn as the various block sections would not engage one another properly; the top rear portion of the zig-zag shapes should meet the corner of the respective block sections. Further, as hidden lines are implemented in the figure, a hidden line should also be drawn to represent the rear bottom face.
- Figures 4 and 5 require bracketing "}".
- Figure 6, 9 and 10 fail to show the lines of the joints which would be visible on the top. Furthermore, it's unclear to what the three dots to the right of figure 9 represent.
- Figure 8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Further, it is

unclear why Figure 8 is even necessary as it appears to be identical to Figure 7 which is indicated as "Prior Art".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 20 and 21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 20 requires

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that the second planes are perpendicular to the first planes. Claim 20 depends from claim 7, which requires the second plane to be transverse to the first planes. The examiner fails to see how claim 20 further limits claim 7 from which it depends. Similarly claims 21 indirectly depends from claim 13 which requires the second planes transverse the first planes.

Claims 10 and 12 are objected to because of the following informalities:

The preamble of the claim does not coincide with independent claim 7. Examiner suggests deleting "having hidden joining marks" from claim 10 & 12. Further, claim 12 recites the limitation "plurality of slats" which lacks proper antecedent basis. It appears claim 12 is referencing the "plurality of first slats" in independent claim 7 rather than the individual wood slat claimed? If this is the case, Examiner suggests replacing "wood" with --first-- in line 2 of claim 12. Appropriate correction is required.

Claim 24 is objected to because of the following informalities: The limitation "the undesirable pattern(s) of the joining marks" lacks proper antecedent basis. It appears claim 24 should be dependent upon claim 23? For purpose of examination claim 24 is examined as recited, as being dependent from claim 21.

Claim 27 is objected to because of the following informalities: To remain consistent with the impendent claim 23, Examiner suggests inserting --finished-- prior to "wood slat" in line 1 of claim 27. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 10, 12 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately describe / enable hidden joining marks. The specification states that the additional processing steps hide the joining marks 32. The examiner disagrees. Joining marks 32 would appear along the top face of the block of Figure 9 as well as the faces of the slats of Figure 10 (Note they would also appear along the top face of the Prior Art block in Figure 6). The additional steps or rejoining and cutting it a transverse plane cannot hide these joins. The joints will remain. They will appear as straight lines rather than in a zig-zag finger joint pattern but they will still be visible and not hidden as described and claimed.

Furthermore, the specification lacks adequate disclosure as to why it necessary to join slats in an order different than the first order. The specification states that rejoining each of the wood pieces in a different order would hide the joining marks to

form a new bulk section. Examiner fails to see how the step of the bulk section being cut into slats and rearranged is necessary, as it would still result in zig-zag and straight line joining marks across the respective faces.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 23, and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kertscher (US 947,001).

With regards to claims 22, 23, and 27-28: PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE FINAL RESULTING STRUCTURE IMPLIED BY THE STEPS

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

Kertscher discloses finished wood slats cut from a laminated bulk section, which is free of any exposed zig-zag lines and free of joining marks exposed on the final face (fig. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7,10, 12-13, 15-17, and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's prior art disclosure (par. 0006-0008) in view of Kertscher (US 947,001).

With regards to claim 7: Applicant discloses a prior art method for making a wood slat, the method comprising:

providing a first bulk section (30) of wood having joining marks (32) that appear in a face plane, the joining marks (32) resulting from rejoining shorter blocks (8) of wood to form the bulk section (30) (fig. 5-6; par. 0006-0007); and

cutting the first bulk section along first parallel planes in a successive first order to form a plurality of first slats each having a face plane (figs. 6-7; par. 0008).

Applicant discloses everything previously mentioned except for joining the face planes of the first slats in an order different than the first order to create a new bulk section in the form of a laminate; and cutting the new bulk section along second parallel planes to form the wood slat, the second parallel planes being generally transverse to the first parallel planes such that the joining marks are substantially hidden in the wood slat.



However, Kethscher discloses cutting a bulk section along first parallel planes to form slats and joining the slats to create a new bulk section in the form of a laminate (figs. 1 & 3; col. 2, lines 64-68). Kertscher further discloses cutting the new bulk section along second planes generally transverse plane in order to create a desired grain pattern (figs. 1 & 3; col. 4, lines 84-109).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the applicant's prior art method to further include the step joining the slats to create a new bulk section in the form of a laminate, in which the laminate is then cut along second parallel planes generally transverse to the first parallel planes as taught Kertscher in order to create a desired grain pattern.

As to the step of joining the faces planes of the first slats in an order different than the first order to create a new bulk section in the form of a laminate, no new or unexpected results would arise from such a step. The first slats are identically cut, therefore rearranging that slats in a different order from which they were cut would not be expected be to hide the joining marks as discussed in par. 0015 of specification. As best understood, applicant's new bulk section in the form of a laminate would be no different than a laminate bulk section not having the first slats placed in a different order. It is further noted that applicant acknowledges that shuffling the order of the first slats is known in the art to exist (line 3-4, pg. 10 of the arguments of 11/16/07).

Further, as best understood, the finished wood slat have substantially hidden joining marks.

With regards to claim 10: Applicant prior art method discloses a first bulk section in the form of a rectangular block (10).

With regards to claim 12: Applicant prior art method, in view of Kertscher, would produce wood slats and a plurality of first slats having a thin rectangular shape.

With regards to claim 13, 15-17 and 21-28: PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE FINAL RESULTING STRUCTURE IMPLIED BY THE STEPS

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

However, the finished wood slats of applicant's prior art method, in view of Kertscher, would appear as the claimed finished slats.

With regards to claim 20: As per the modification of claim 27, the second parallel planes are generally perpendicular to the first parallel planes.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

However, applicant argues that the lines of the joints with respect to figure 6, 9, 10 are not visible because of the marking or shuffling and cutting of bulk section.

Applicant's arguments are found not persuasive. In response, Examiner notes that the markings do not cover the entire area nor would they completely hide the joints. Furthermore, each slat has a thickness not affected by marking or cutting and reshuffling, therefore leaving areas not disturbed (see figs. 6, 9-10).

Applicant argues that fig. 8 is not "Prior Art" per se as fig. 8 is viewed together with figs. 9 and 10. Applicant's arguments are not found persuasive, as applicant clearly discloses in the specification that such a step is prior art. Examiner notes that figs. 4-7, which are labeled "prior art" are viewed together with fig. 9-10 as they are part of applicant's sequence of producing wood slats.

Applicant further argues that the objections to claims 20-21 should be withdrawn as "perpendicular" further limits "transverse". Applicant's arguments are not found persuasive. Merriam-Webster Dictionary defines transverse as: 1 : acting, lying, or being across : set crosswise 2 : made at right angles to the long axis of the body <a *transverse* section>. Examiner notes applicant's claims are directed to planes generally transverse to one another which is considered to be equivalent to generally perpendicular, note recited definition above.

The rejection of claim 22-28 under 35 U.S.C. 112, second paragraph in view of the amendment filed 11/16/08.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./  
Examiner, Art Unit 3633

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635